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T-D

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/054,602	04/03/98	SMITH D	74311ACFR

001333
PATENT LEGAL STAFF
EASTMAN KODAK COMPANY
343 STATE STREET
ROCHESTER NY 14650-2201

IM52/1101

EXAMINER	
REDDICK,M	
ART UNIT	**PAPER NUMBER**
1713	15

DATE MAILED: 11/01/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/054,602	Applicant(s) SMITH ET AL.	
	Examiner Judy M. Reddick	Art Unit 1713	

-- The MAILING DATE of this communication appears on the cov r sheet with th correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 August 2001* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5,11-23 and 25* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5,11-23 and 25* is/are rejected.

7)☒ Claim(s) *1,3,5,12,18 and 21* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Objections

1. Claims 1, 3, 5, 12, 18 and 21 are objected to because of the following informalities: In claim 3, "an acrylic acid and a methacrylic acid" per claim 3 should read "acrylic acid and methacrylic acid", as originally claimed. An apology is extended to applicants for the misleading communication in the previous Office Action; In claims 1 and 5, it is believed that "20 %" should read "20 % by weight" and "10 % to 50 %" should read "10 % to 50 % by weight", respectively. In claim 12(renumbered), "6" should read "11"; In claim 18(renumbered), line 1, "12" should read "17"; In claim 21(renumbered), "15" should read "20". Appropriate correction is required.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> ***(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.***

3. The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. ***Determining the scope and contents of the pri r art.***
2. ***Ascertaining the differences between the prior art and the claims at issue.***

3. *Res lving the level of ordinary skill in the pertinent art.*
4. *Considering bjective evidence present in the application indicating obvi usness or non bvi usness.*

4. Claims 1-5 and 11-23 stand rejected under 35 U.S.C. 103(a) as being unpatentable over McNeil'295 as per reasons clearly set forth in the previous Office Action per paper no. 13, 05/21/01.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> *A person shall be entitled to a patent unless –*
>
> *(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.*

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> *(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.*

7. Claims 1-5, 11-23 and 25 stand rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Utsumi et al'847 as per reasons set forth in a previous Office Action per paper no. 13, 05/21/01.

> *(e) the inventi n was described in a patent granted n an applicati n f r patent by another filed in the United States bef re the inventi n there f*

by the applicant for patent, r on an internati nal applicati n by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the inventi n there f by the applicant for patent.

8. Claims 1-5, 11-23 and 25 stand rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kamiyama et al'394 as per reasons set forth in a previous Office Action per paper no. 13, 05/21/01.

Response to Arguments

9. Applicant's arguments filed 08/23/01 have been fully considered but they are not persuasive.

Relative to McNeil---The size of the particulate stabilizer is generic in size and therefore necessarily implies that any size, including the claimed particulate stabilizer having a size of less than 100 nm, would have been operable within the scope of patentees invention and with a reasonable expectation of success.

With all due respect to Counsel's opinion, "monocarboxylic acids and their derivatives" are taught as equivalents in scope and authorized in content of from 1 to 99 % by weight. More specifically, it is maintained that one of ordinary skill in the art would have readily envisioned the use of a mono-carboxylic acid monomer in lieu of the n-butyl methacrylate component per Run III in an amount of 42 weight %, based on their equivalently taught scope. Further, one of ordinary skill in the art would have readily envisioned the use of an inorganic salt in Run III

foll wing the guidelines f McNeil at, e.g., c l. 6-9 and in the claims. It is interesting to n te that claim 1 is void f any c ntent of a stabilizer.

Relative to Utsumi et al—*While counsel argues that there is no guidance to use a carboxylic acid-containing monomer, counsel is referred to col. 4, lines 26-30 wherein a combination of a monomer having a carboxyl group + lithium phosphate(which meets the water-soluble inorganic salt per the claims since no degree of solubility is recited) is taught as operable within the scope of patentees invention.*

Relative to Kamiyama et al—*With all due respect to Counsel's opinion, one of ordinary skill in the art would have readily envisioned the use of acrylic acid in lieu of the 20 wt.% of the butyl acrylate component per Run 3 following the guidelines of patentee at col. 10, lines 15-16 who recognizes the equivalence in scope of acrylic acid and derivatives thereof such as butyl acrylate.*

112 issue—*Counsel is herein apprised that a future rejection under 35 U.S.C. 112, second paragraph can be precluded by differentiating over "insoluble metal oxide" and "oxide" per claim 22. The rejection is not being made at this time since the outstanding rejections appear to be valid.*

Conclusion

10. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A sh rtened statutory period for reply to this final acti n is set to expire THREE MONTHS from the mailing date of this acti n. In the event a first reply

is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (703)308-4346. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (703)308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9310 for regular communications and (703)892-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-8183.

J. M. Reddick

Judy M. Reddick
Primary Examiner
Art Unit 1713

JMR
October 31, 2001